

REMARKS/ARGUMENTS

Claims 1-5, 7-15, 17-18 and 20-23 were pending in this application. Claim 20 has been amended. No claims have been added or cancelled. Hence, claims 1-5, 7-15, 17-18 and 20-23 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-5, 7-15, 17-18 and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the cited portions of U.S. Patent No. 6,397,194 to Houvener, *et al.* (hereinafter "Houvener"), and further in view of the cited portions of U.S. Patent Publication No. 2001/0029470 A1 to Schultz, *et al.* (hereinafter "Schultz").

Claim 20 has been amended to correct the reference to previously-canceled claim 19. No new matter has been added.

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicant respectfully traverses the rejection of all claims since the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. All claims are rejected as being unpatentable over Houvener in view of Schultz. Houvener and Schultz, however, are in different areas of endeavor, which renders the combination inappropriate since one would not be motivated to combine the references and the combination can not be reasonably expected to successfully produce the Applicant's claimed invention.

Houvener teaches a receipt scanning system and method (See, Title). According to Houvener, a paper receipt is scanned into a system for later recall. Schultz, on the other hand,

relates to electronic receipts (See, Abstract). There is no reason one attempting to create the Applicant's claimed invention would look to Houvener and Schultz, since the two are in different areas of endeavor. Hence, there is no motivation to combine the references.

This point is further supported by the statement in Houvener that the receipt to be scanned (i.e., document 8) "must at least include a signature of the person initiating the financial transaction" (col. 6, ll. 59, 60). Because Schultz relates to an electronic purchasing environment in which a signature receipt never exists – and Schultz mentions nothing about a signature or signature image – the two references cannot be combined. In other words, it is literally impossible to combine the two since the receipt having a signature on which the system of Houvener operates is never produced by Schultz. Hence, there is no motivation to combine Houvener with Schultz, and all pending claims are believed to be allowable for at least this reason.

Moreover, the combination of Houvener with Schultz would not reasonably be expected to successfully produce the Applicant's claimed invention. As stated previously, Houvener teaches a receipt scanning system, and Schultz teaches a system in which a paper receipt never exists. Hence, Schultz produces nothing for Houvener to scan, and all pending claims are believed to be allowable for this additional reason.

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PATENT




CONCLUSION

In view of the foregoing, the Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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